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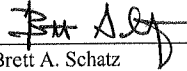
Filing date: **07/12/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
Party	Defendant Nalge Nunc International Corporation Nalge Nunc International Corporation 75 Panorama Creek Drive Rochester, NY 146020365
Correspondence Address	DONALD F. FREI WOOD, HERRON & EVANS, L.L.P. 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202-2917
Submission	Other Motions/Papers
Filer's Name	Brett A. Schatz
Filer's e-mail	bschatz@whepatent.com,sgraber@whepatent.com,afreeman@whepatent.com
Signature	/Brett A. Schatz/
Date	07/12/2006
Attachments	Motion Protective Order.pdf ( 3 pages )(87998 bytes ) Memo-Protective Order.pdf ( 8 pages )(386814 bytes ) Memo Protective Order-Exhibits.pdf ( 31 pages )(2239084 bytes )

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, on the date shown below:

  
Brett A. Schatz

7/12/06  
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application, Serial No. 76/572,253 )

TriForest Enterprises, Inc. )

Opposer, )

v. )

Nalge Nunc International Corporation )

Applicant-Respondent. )

Opposition No. 91165809

Application No.: 76572253

Mark: plastic water bottle (design only)

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

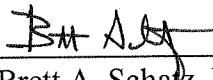
**APPLICANT'S MOTION FOR PROTECTIVE ORDER**

Pursuant to 37 C.F.R. § 2.120(f) and Rule 37 of the Federal Rules of Civil Procedure, Applicant, Nalge Nunc International Corporation ("Nalge"), moves the Trademark Trial and Appeal Board for an order precluding Opposer from taking trial testimony from Mr. Syed Rehan. Opposer failed to identify Mr. Rehan as a witness during the discovery period, despite Nalge's discovery requests seeking precisely this information. Now, Opposer is attempting to ambush Nalge by seeking to take testimony from Mr. Rehan during Opposer's trial testimony period. This Motion is supported by the accompanying Memorandum in Support and exhibits thereto.

WHEREFOR, Nalge respectfully requests that the Board grant this Motion.

Respectfully submitted,  
Nalge Nunc International Corporation

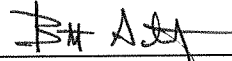
Date: July 12, 2006

  
\_\_\_\_\_  
Brett A. Schatz, Esq.  
Sarah Otte Graber, Esq.  
Theodore R. Remaklus, Esq.  
Wood, Herron and Evans  
2700 Carew Tower  
441 Vine Street  
Cincinnati, Ohio 45202-2917

Attorneys for Applicant,  
Nalge Nunc International Corporation

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **APPLICANT'S MOTION FOR PROTECTIVE ORDER** was served by e-file copy and by regular mail, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 12th day of July, 2006.



---

Brett A. Schatz, Esq.  
Sarah Otte Graber, Esq.  
Theodore R. Remaklus, Esq.  
WOOD, HERRON & EVANS, L.L.P.  
441 Vine Street, 2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324  
Attorneys for Applicant  
Nalge Nunc International Corporation

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Brett A. Schatz  
Brett A. Schatz

7/12/06  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application, Serial No. 76/572,253

TriForest Enterprises, Inc.

Opposer,

v.

Nalge Nunc International Corporation

Applicant-Respondent.

)  
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) Opposition No. 91165809  
) Application No.: 76572253  
) Mark: plastic water bottle (design only)  
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Commissioner for Trademarks  
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P.O. Box 1451  
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**APPLICANT'S MEMORANDUM IN SUPPORT  
OF ITS MOTION FOR PROTECTIVE ORDER**

**I. INTRODUCTION**

During the discovery period in this matter, Applicant Nalge Nunc International Corporation ("Nalge") served Opposer with discovery requests seeking, among other things, the identity of certain individuals Opposer would call as witnesses in support of its case. For example, Nalge requested Opposer to identify (a) all persons knowledgeable about Opposer's sales and distribution, (b) all persons with whom Opposer has had contact relating to Nalge's mark, and (c) all persons Opposer expects to testify, including the subject matter, facts, and opinions about which each is expected to testify.

In response to Nalge's discovery requests, Opposer identified Mr. Steve Lin, Opposer's company officer. No other witnesses were identified. Now, Opposer is attempting to ambush Nalge with testimony from Mr. Syed Rehan, a previously unidentified witness. Of course, due to the fact that Opposer concealed Mr. Rehan's identity, Nalge did not have the opportunity to depose him during the discovery period. In sum, Nalge specifically requested Opposer to identify its witnesses and Opposer shrugged off Nalge's requests, snubbing the rules governing this Opposition, including the Federal Rules of Civil Procedure. Since Opposer did not identify Mr. Rehan as a witness, Opposer should be precluded from offering him as a witness.

Counsel for Nalge confirms that a good faith effort has been made by correspondence to resolve with counsel for Opposer the issues presented in this Motion. In particular, in letters dated July 3 and 10, 2006, counsel for Nalge informed counsel for Opposer that Mr. Rehan was not properly identified as a witness during the discovery period and therefore is not a proper witness. (See July 3 and 10, 2006 letters, attached as Exhibit A). To date, counsel for Opposer has not agreed to withdraw Mr. Rehan as a witness. In fact, counsel for Opposer has not responded to any of the letters mentioned above.

## **II. ARGUMENT**

### **A. Opposer Did Not Identify Mr. Rehan As A Witness**

During the discovery period, Nalge served Opposer with Interrogatories specifically requesting Opposer to identify the witnesses from whom it would elicit testimony on particular issues involved in this Opposition. For example, Nalge served the following Interrogatories:

**Interrogatory No. 2:** Identify the persons most knowledgeable about Opposer's sales, marketing, distribution, advertising and promotion, use and licensing of goods identified in response to Interrogatory No. 1.

**Interrogatory No. 10:** For each product identified in response to Interrogatories Nos. 1 and 7, list all persons knowledgeable about the sales, accounting, distribution and promotion of such product(s).

**Interrogatory No. 28:** Identify all persons or entities, other than Applicant, and set forth with specificity all facts with whom Opposer has had contact regarding, relating or referring to Applicant's Mark, and identify all supporting documents related thereto.

**Interrogatory No. 33:** Identify each witness that Petitioner expects to testify, the subject matter to which the witness is expected to testify, each fact and/or opinion to which the witness is expected to give, the bases for each statement or opinion and identify all documents related thereto.

(See Opposer, Triforest Enterprises, Inc.'s Response to Applicant's First Set of Interrogatories, at pp. 3, 6-7, 20-21, attached hereto as Exhibit B).

Opposer identified only Mr. Steve Lin in response. (See Exhibit B). Despite having identified only Mr. Lin in response to Nalge's discovery requests, Opposer is presently attempting to ambush Nalge by seeking trial testimony from a previously unidentified witness, Mr. Syed Rehan. On June 23, 2006, nearly five months after the close of the discovery period<sup>1</sup>, Opposer served Nalge with Opposer, Triforest Enterprises, Inc.'s Notice of Taking Testimony by Depositions. (See Exhibit D). This was the first time Opposer disclosed Mr. Rehan's identity, despite Nalge's discovery requests specifically requesting this information several months prior.

**B. Opposer Should Be Precluded From Ambushing Nalge With Mr. Rehan's Testimony**

Rule 37(c)(1) of the Federal Rules of Civil Procedure provides:

A party that without substantial justification fails to disclose information required by Rule 26(a) or 26(e)(1), or to

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<sup>1</sup> The discovery period closed on January 27, 2006. (See Trial Schedule, attached hereto as Exhibit C).

amend a prior response to discovery as required by Rule 26(e)(2), is not, unless such failure is harmless, permitted to use as evidence at a trial, at a hearing, or on a motion any witness or information not so disclosed.

In *Bison Corp. v. Perfecta Chemie B.V.*, 4 U.S.P.Q. 2d 1718 (TTAB 1987), the TTAB expressed the following thoughts in response to a party's failure to properly respond to discovery requests:

The purpose of discovery is to provide information which may aid a party in the preparation of its own case or in the cross-examination of its adversary's witnesses. It is unfair for a party to withhold documents requested or refuse to answer interrogatories posed by its adversary or, as appears to be the case here, fail to make a complete investigation to locate the information.

*Id.* at 1720.

With respect to the identity of witnesses, complete responses are critical for the preparation of the discovering party's case. See *American Optical Corp. v. Exomet, Inc.*, 181 U.S.P.Q. 120, 122 (TTAB 1974) ("...applicant has gone on to furnish the names and addresses of these people. It is adjudged that applicant's response to these questions [seeking the identity of witnesses] has been adequate since it will enable opposer to take the discovery depositions of these individuals who have apparently been designated by applicant as having knowledge of its activities.")

When a party fails to identify a witness during discovery, precluding the witness' testimony is appropriate under the Rules of Federal Procedure. See *Black v. Columbus Public Schools*, 124 F.Supp. 2d 550, 561 (S.D. Oh. 2000) ("In its Reply Memorandum, [the defendant] moves to strike Mrs. Fischer's affidavit on several grounds. First, Mrs. Fischer was not identified as a witness during discovery...Based on these facts, Defendant did not depose Mrs. Fischer...Additionally, the Court relies on Fed. R. Civ. P. 37(c)(1) to strike the Fischer Affidavit, because Plaintiff failed to disclose Mrs. Fischer as a witness during discovery."); see also



*Hancock v. Hobbs*, 967 F.2d 462, 468 (11<sup>th</sup> Cir. 1992) ("In light of the fact that Hancock failed to disclose Potter's identity and the substance of his testimony until five months after retaining him in September 1989 – and over three months after the close of an extended period of discovery – we hold that the district court did not abuse its discretion in excluding the testimony of Hancock's expert witness."); *Thibeault v. Square D Company*, 960 F.2d 239, 246-47 (1<sup>st</sup> Cir. 1992) ("Many courts - this court included – have recognized that the introduction of new expert testimony on the eve of trial can be seriously prejudicial to the opposing party."); *Perkasie Indus., Corp. v. Advance Transformer, Inc.*, 143 F.R.D. 73, 76-77 (E.D.Pa. 1992) ("A party is not permitted to postpone identification of its own witnesses and the substance of their testimony until a critical point in the proceedings at which it will become extremely burdensome for his opponent to prepare effectively to meet them.")

Opposer failed to identify Mr. Rehan as a witness, preventing Nalge to effectively prepare to cross-examine him at his trial deposition. Opposer should not be rewarded for its sandbagging tactics. Therefore, Mr. Rehan's testimony should not be allowed.

**C. Mr. Rehan's Testimony May Be Not Relevant  
And Should Be Excluded**

Because Opposer failed to identify Mr. Rehan as a witness during the discovery period, it is unknown what his testimony may entail. It may not be relevant, which in such case it should be excluded as not having a tendency to make the existence of any fact that is of consequence in this case more or less probable.

Rule 402 of the Federal Rules of Evidence provides in part that "[e]vidence which is not relevant is not admissible." Rule 401 defines "relevant evidence":

'Relevant evidence' means evidence having any tendency to make the existence of any fact that is of consequence to the determination of the action more probable or less probable than it would be without the evidence.

Fed. R. Evid. 401. Therefore, under Rules 401 and 402, any evidence that does not have a tendency to make the existence of any fact that is of consequence more or less probable should be excluded. *Fisher v. Wellington Exempted*, 223 F.Supp. 2d 833, 855-856 (N.D. Oh. 2002). (district court grants a motion in limine excluding from trial evidence that does not tend to make the existence of a fact in consequence more or less probable.)

Even evidence deemed relevant under Rules 401 and 402 may be excluded under certain circumstances, for example under Rule 403. Under Rule 403,

evidence may be excluded if its probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury...

Fed. R. Evid. 403. "The trial court is granted broad discretion when deciding whether to exclude evidence pursuant to Rule 403." *United States v. Vance*, 871 F.2d 572, 576 (6<sup>th</sup> Cir. 1986). Thus, a trial court's decision to exclude evidence will only be reviewed under an abuse of discretion standard. *United States v. Feinman*, 930 F.2d 495, 499 (6<sup>th</sup> Cir. 1991); *see also In re Bendectin Litigation*, 857 F. 2d 290, 322 (6<sup>th</sup> Cir. 1988) (affirming a trial court's decision to exclude evidence under Rule 403 and noting that "if judicial self-restraint is ever desirable, it is when a Rule 403 analysis of a trial court is reviewed by an appellate tribunal. . . . The draftsman intended that the trial judge be given a very substantial discretion in 'balancing' probative value on the one hand and 'unfair prejudice' on the other, and that he should not be reversed simply because an appellate court believes that it would have decided the matter otherwise . . . ")

However, the Court must first make a determination if the proposed evidence is relevant; if it is

not, the evidence is to be excluded under Rules 401-402, and Rule 403 need not to be considered.

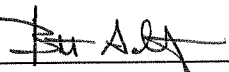
*United States v. Zelinka*, 862 F.2d 92, 99 (6<sup>th</sup> Cir. 1988).

### III. CONCLUSION

For all the foregoing reasons, Applicant Nalge Nunc International Corporation requests its Motion for Protective Order be granted.

Respectfully submitted,

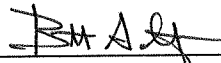
Dated: July 12, 2006

  
\_\_\_\_\_  
Brett A. Schatz, Esq.  
Sarah Otte Graber, Esq.  
Theodore R. Remaklus, Esq.  
WOOD, HERRON & EVANS, L.L.P.  
441 Vine Street, 2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324  
(513) 241-6234 (Facsimile)  
Attorneys for Applicant  
Nalge Nunc International Corporation

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **APPLICANT'S MEMORANDUM IN SUPPORT OF ITS MOTION FOR PROTECTIVE ORDER** was served by e-file copy and by regular mail, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 12th day of July, 2006.

Dated: July 12, 2006



---

Brett A. Schatz, Esq.  
Sarah Otte Graber, Esq.  
Theodore R. Remaklus, Esq.  
WOOD, HERRON & EVANS, L.L.P.  
441 Vine Street, 2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324  
Attorneys for Applicant  
Nalge Nunc International Corporation

# WOOD, HERRON & EVANS, LLP

BRUCE TITTEL  
DAVID S. STALLARD  
J. ROBERT CHAMBERS  
GREGORY J. LUNN  
KURT L. GROSSMAN  
CLEMENT H. LUKEN, JR.  
THOMAS J. BURGER  
GREGORY F. AHRENS  
WAYNE L. JACOBS  
KURT A. SUMME  
KEVIN G. ROONEY  
KEITH R. HAUPT  
THEODORE R. REMAKLUS  
THOMAS W. HUMPHREY  
SCOTT A. STINEBRUNER  
DAVID H. BRINKMAN  
BEVERLY A. LYMAN, Ph.D.  
KRISTI L. DAVIDSON  
KATHRYN E. SMITH  
P. ANDREW BLATT, Ph.D.  
DAVID E. JEFFERIES

2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OHIO 45202-2917

TELEPHONE: 513-241-2324

FACSIMILE: 513-241-6234

WEBSITE: www.whopatent.com

PATENT, TRADEMARK, COPYRIGHT  
AND UNFAIR COMPETITION LAW  
AND RELATED LITIGATION

EDMUND P. WOOD 1923-1968  
TRUMAN A. HERRON 1935-1976  
EDWARD B. EVANS 1936-1971

JOSEPH R. JORDAN  
C. RICHARD EBY

WILLIAM R. ALLEN, Ph.D.  
JOHN PAUL DAVIS  
DOUGLAS A. SCHOLER  
BRETT A. SCHATZ  
DAVID W. DORTON  
SARAH OTTE GRABER  
STEVEN W. BENINTENDI, Ph.D.  
RANDALL S. JACKSON, JR.  
CARL J. BRAUCH

OF COUNSEL

JOHN D. POFFENBERGER  
DAVID J. JOSEPHIC  
DONALD F. FREI  
THOMAS W. FLYNN  
J. DWIGHT POFFENBERGER, JR.  
BRADLEY D. BECK

July 3, 2006

Via Facsimile and Email

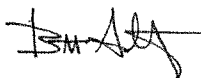
Clement Cheng, Esq.  
Law Offices of Clement Cheng  
17220 Newhope Street, Suite 127  
Fountain Valley, California 92708

Re: U.S. Trademark Application Serial No. 76/572,253  
Opposition No. 91165809  
TriForest Enterprises, Inc. v. Nalge Nunc International Corporation  
Our Ref.: NAC-125OP

Dear Mr. Cheng:

We are in receipt of Opposer, Triforest Enterprises, Inc.'s Notice of Taking Testimony By Depositions. While we are prepared to participate in the deposition of Mr. Lin, we object to any testimony from Mr. Syed Rehan, and will not be participating in his deposition. At no time during the discovery period did you identify Mr. Rehan as a witness, despite discovery requests seeking this information. Please confirm that you will not be proceeding with Mr. Rehan's deposition or using him as a witness, no later than July 7, 2006. Otherwise, we will take the issue up with the Board.

Regards,

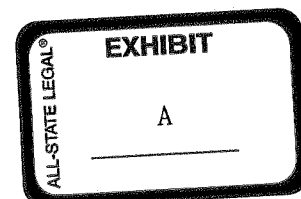


Brett A. Schatz

BAS:alf

cc: Denise Riemann, Ph.D., Esq.  
Sarah Otte Graber, Esq.

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WOOD, HERRON & EVANS, LLP

BRUCE TITTEL  
DAVID S. STALLARD  
J. ROBERT CHAMBERS  
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KURT L. GROSSMAN  
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KRISTI L. DAVIDSON  
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PATENT, TRADEMARK, COPYRIGHT,  
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DAVID J. JOSEPHIC  
DONALD F. FREI  
THOMAS W. FLYNN  
J. DWIGHT POFFENBERGER, JR.  
BRADLEY D. BECK

July 10, 2006

Via Facsimile and Email

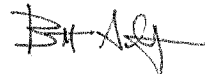
Clement Cheng, Esq.  
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Fountain Valley, California 92708

Re: U.S. Trademark Application Serial No. 76/572,253  
Opposition No. 91165809  
TriForest Enterprises, Inc. v. Nalge Nunc International Corporation  
Our Ref.: NAC-125OP

Dear Mr. Cheng:

You have yet to respond to my letter of last week regarding Mr. Syed Rehan. Please confirm that you will not be proceeding with Mr. Rehan's deposition or using him as a witness. Otherwise, we will take the issue up with the Board.

Regards,



Brett A. Schatz

BAS:alf

cc: Denise Riemann, Ph.D., Esq.  
Sarah Otte Graber, Esq.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<u>In re Application, Serial No. 76/572,253</u>	)	
TriForest Enterprises, Inc.	)	
	)	Opposition No.: 91165809
Opposer,	)	
	)	
Nalge Nunc International Corporation,	)	
	)	
Applicant/Respondent.	)	
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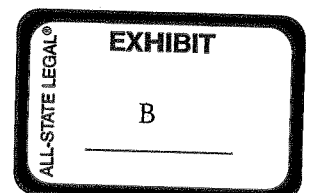
**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S  
FIRST SET OF INTERROGATORIES**

In accordance with Rule 34 of the Federal Rules of Civil Procedure and Rules 2.116 and 2.120 of the Trademark Rules of Practice, TriForest Enterprises, Inc. ("TriForest") responds to the following interrogatories of Nalge Nunc International Corporation ("Nalge").

**GENERAL STATEMENTS AND OBJECTIONS**

**General Statements**

- A. Responding Parties reserve the right to supplement or amend these responses in the event that any facts, documents, or other evidence may subsequently be discovered.
- B. These responses are made without prejudice to Responding Parties right to introduce facts, documents, witnesses, or other evidence may be subsequently discovered.
- C. These responses are made without prejudice to Responding Parties' right to supplement or amend these responses in the event that any information previously available to Responding Parties may have been omitted by oversight, inadvertence, or good faith error or mistake.



- D. Except for the facts explicitly stated herein, no incidental or implied admissions are intended.
- E. Responding Parties expressly reserves:
  - a. All objections regarding the competency, relevance, materiality, probative value and admissibility of all information provided, documents produced and the contents thereof;
  - b. All objections as to vagueness, ambiguity, unintelligibility and overbreadth.
- F. Nothing Herein shall be construed as an admission by Responding Parties regarding the admissibility or relevance of any fact or document or of the truth or accuracy of any characterization contained in Propounding Parties' discovery requests.
- G. These responses are signed by counsel only as to the objections set forth in the responses. Responding parties specifically claims the attorney-client privilege and/or the attorney-work product privilege as to each and every response set forth herein.
- H. The fact that part or all of any discovery request has been answered should not be construed to be a waiver of any objection to any discovery request.
- I. Responding Parties responds to each and every discovery request subject to the foregoing, and each of the forgoing statements and objections is incorporated by reference into each of the following responses.

#### **General Objections**

- A. Opposer objects to these requests to the extent they seek the production of information, documents or things, which are subject to the attorney client privilege, attorney work product or other privilege or exemption from discovery.
- B. Opposer objects to these requests to the extent they seek the production of information, documents or things, which constitute or would reveal trade secrets or confidential business information belonging to Opposer.



C. Opposers objects to these requests in so far as they seek the production of information, documents or things which are irrelevant or in material and are not reasonably calculated to lead to the discovery of admissible evidence, are not within the possession or control of Opposer, or are otherwise beyond the scope of the Federal Rule of Civil Procedure.

### **INTERROGATORIES**

#### **INTERROGATORY NO. 1:**

Identify in detail each good with which Opposer has used, uses and intends to use Applicant's Mark or a configuration similar to Applicant's Mark, including without limitation, the configuration shown in U.S. Patent Application 10/759,659.

#### **RESPONSE TO INTERROGATORY NO. 1:**

Opposer previously sold the boston round that was claimed to be infringing. After receiving cease and desists from Apogent, opposer agreed to change the product configuration. Opposer incurred substantial cost to change the product configuration.

The opposer has no intent to use the functional features that are claimed in applicants mark, but would certainly like to because the particular features all have different utilitarian advantages. Opposer would like to avoid litigation and would only use the set of functional features if this opposition is successful.

#### **INTERROGATORY NO. 2:**

Identify the persons most knowledgeable about Opposer's sales, marketing, distribution, advertising and promotion, use and licensing of goods identified in response to Interrogatory No. 1.

#### **RESPONSE TO INTERROGATORY NO. 2:**

Steve Lin

#### **INTERROGATORY NO. 3:**

For each of the goods identified in response to Interrogatory No. 1, identify the first date, and each month thereafter, when Opposer used such goods, and produce all documents supporting such information.

#### **RESPONSE TO INTERROGATORY NO. 3:**

The Boston round has been sold as early as 2001 and in various configurations thereafter. The original product was canceled due to Apogent's threats, parent company of applicant.

**INTERROGATORY NO. 4:**

Identify each country, state or city, its territories and possessions, in which Opposer:

- A. is formally organized;
- B. is qualified under applicable law to do business as a foreign entity;
- C. has corporate headquarters maintained, including the exact street address and phone number of Opposer's main office; and
- D. owns, maintains or leases office or warehouse space.

**RESPONSE TO INTERROGATORY NO. 4:**

Opposer is a California corporation and other details are available at the Secretary of State website.

**INTERROGATORY NO. 5:**

Describe in detail the corporate structure of Opposer, including the identity of any and all entities related to or affiliated with Opposer.

**RESPONSE TO INTERROGATORY NO. 5:**

The opposer objects to this interrogatory as seeking trade secret information. Opposer objects to the interrogatory as not relevant.

**INTERROGATORY NO. 6:**

Identify all officers of Opposer since 2000.

**RESPONSE TO INTERROGATORY NO. 6:**

The opposer objects to this interrogatory as seeking trade secret information. Opposer objects to the interrogatory as not relevant. The officer would not be available in any case because the discovery cut off has terminated all right to depositions. Without waiving any of the objections, Steve Lin has been an officer since 2000.

**INTERROGATORY 7:**

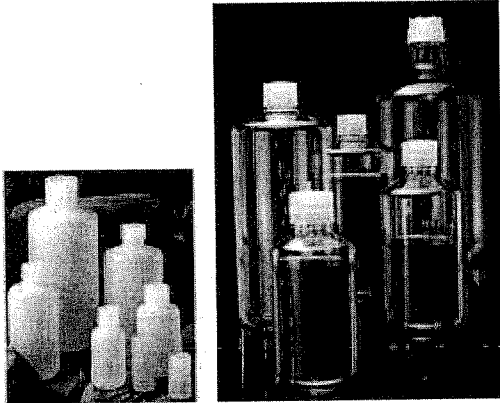
Identify all products or devices manufactured or distributed by Opposer that Opposer believes is or will be adversely affected by the registration of Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 7:**

The cease and desist letters contain allegations that substantially broaden the original

Patent like claims issued by the trademark Office. Therefore, opposer is not able to figure out exactly which products it will suffer legal problems but it could be many. A simple pictorial argument is as follows:

Start with a Nalgene Boston Round Lab bottle



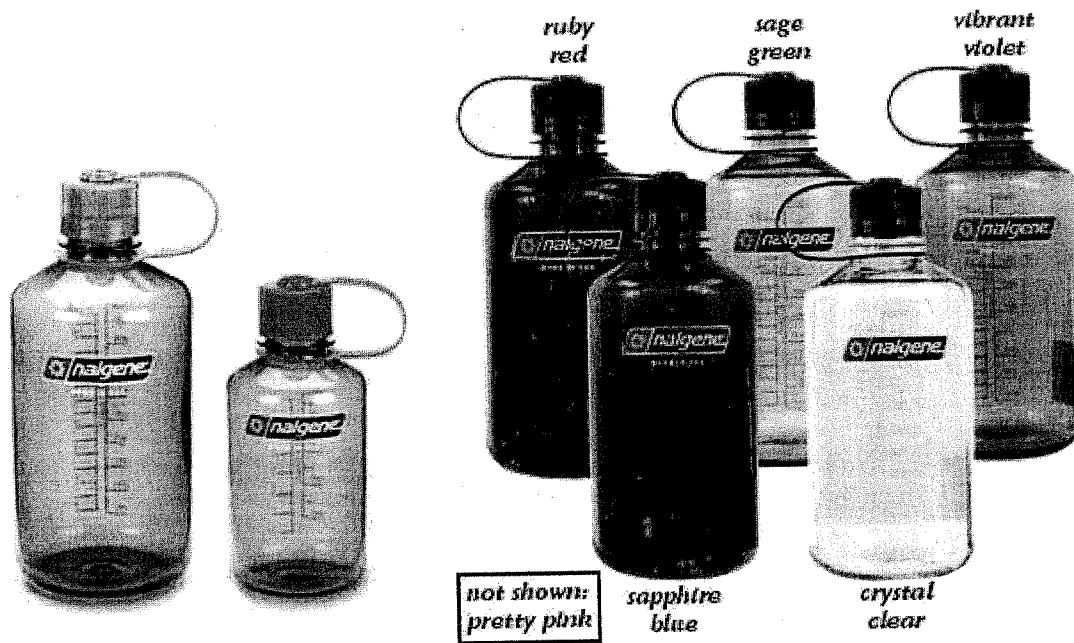
Add the tether cap



to create these Nalgene items



Now Nalgene claims to have a mark on the diverse bottles as shown:



**INTERROGATORY NO. 8:**

Describe in detail all past, existing and potential relationships, including, without limitation, contracts, agreements, licenses, assignments, negotiations to license or other grant of rights, or other relationships, between Opposer and any third party, relating to products bearing Applicant's Bottle Configuration or a similar configuration.

**RESPONSE TO INTERROGATORY NO. 8:**

Opposer objects to this interrogatory as over broad, compound and is difficult to logically answer. Opposer does not license the product and does not have a claim to applicants bottle configuration. Opposer believes that applicants bottle configuration is a public domain configuration that does not have distinctive relationship to any particular source of goods.

**INTERROGATORY NO. 9:**

For each product identified in response to Interrogatories Nos. 1 and 7, state the date of first sale in the United States.

**RESPONSE TO INTERROGATORY NO. 9:**

Because the opposer did not exist before Dec 2001, the first date of the earliest sale of any bottle would be after 2001.

**INTERROGATORY NO. 10:**

For each product identified in response to Interrogatories Nos. 1 and 7, list all persons

knowledgeable about the sales, accounting, distribution and promotion of such product(s).

**RESPONSE TO INTERROGATORY NO. 10:**

Steve Lin

**INTERROGATORY NO. 11:**

Set forth with specificity the circumstances and all facts regarding, relating or referring to the selection by Opposer of the configurations of the goods identified in response to Interrogatory No. 1, and identify all documents related thereto.

**RESPONSE TO INTERROGATORY NO. 11:**

The applicant has the current statement of the trademark in the trademark Office as: The mark consists of a plastic water bottle as shown, namely, a plastic water bottle having a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively; an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem; and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8.

The opposer designed the original bottle based on a review of various Boston round designs. The opposer then created the original bottle based on efficient engineering principles. The original bottle is made of plastic because plastic is a good material to make a water bottle. Plastic is generally well accepted as a way of making a bottle. Plastic is relatively inexpensive compared to stainless steel or silver. Plastic is watertight and can seal water within a closed container. Plastic can also be formed with a closure that is threaded and watertight. Plastic is a petroleum derivative that is relatively abundant compared to metal. The opposer did not make the bottles out of wood, stone or soap because these materials are not as durable. A soap bottle would dissolve in water and a wooden bottle would split and is not well suited for holding a

liquid. During the autoclave process, the plastic is particularly well-suited for the construction of the bottle.

The opposer made bottles that were transparent so that users could look into the container and see if there are contents within the container. Transparency of the bottle also provides a user with the opportunity to determine the quantity of liquid within the bottle. Transparency also allows a user to determine if there are color changes or any other types of qualitative change within the bottle. Transparency is particularly useful during hiking because a foreign object could accidentally fall inside the bottle and a user may drink the foreign object by accident if the user could not see inside the bottle. In laboratory tests, a user may see foreign objects that have accidentally fallen inside of the bottle that may change the results of any laboratory tests. In laboratory use, the bottle often has a media inside that is supposed to be sterile. Having a transparent surface allows a laboratory worker to look inside of the bottle to see if there is anything foreign, such as an insect like a mosquito, fly, mayfly or cockroach. The transparency of the bottle is also helpful for a user because the user can see if the bottle is clean. If the bottle is dirty, the user may want to clean the bottle. If the user wants a dirty bottle, having a transparent surface would insure that there is debris in the bottle. Overall, transparent bottles have been in use since early glass bottles. Early glass bottles are ancient.

The bottle is generally cylindrical with rounded shoulders because some machines roll the bottle. Also, the bottle been generally cylindrical with rounded shoulders allows a greater volume to surface area ratio. This is helpful when optimizing construction so that the plastic use is minimized and the strength of the bottle is maximized. The rounded shoulders interconnect with the upper and lower extremities of the cylindrical sidewalls because if they were not connected, the bottle would fall apart and the contents will leak out. It is better that the bottles are made of integrally formed or blown pieces, rather than pieced together from a number of independent interlocking pieces.

The relatively narrow container neck is commonly known as a narrow mouth bottle. The narrow mouth bottle is good because it is easier to pour of the contents or to drink from the bottle. If the

mouth is too large, it is easier to spill all over the place. The narrow mouth bottle is a very good configuration. There are a wide number of narrow mouth bottles such as milk bottles. Milk is put into bottles that have a narrow mouth because this makes it easier to pour the milk. Orange juice is also put into bottles that have a narrow mouth because it is easier to pour the orange juice. A variety of liquids can be put into a narrow mouth bottle allowing easier pouring of the contents. This applies to granular media such as sand, or coffee grounds as well. When a person purchases a can of coffee at the store that is in the 5 lb. canned version, the person needs to use the scoop that that can comes with because it is hard to pour out of a can that has a large diameter. The contents will pour out of the middle portion of the mouth, but also out of the sides of the mouth. The stream of contents is proportional to the radius of the bottle opening.

The bottle has a generally flat container bottom that is circular because the bottle is in the shape of a cylinder. The circular bottom is formed by the bisecting plane between the cylinder and a plane. The flat bottom is very helpful. If the bottom is not flat, the bottle has a tendency to tip over. The bottle should not tip over. If the bottle tips over the contents will pour out. Having a flat bottom is the best way to keep the bottle from tipping over. Alternative methods such as using adhesive resin to bond the bottle to a table is not as good because the bottle would become stuck and difficult to remove from a table. The bottle could also be made to have a circular depression such that the bottom of the bottle forms a rim. This is helpful for strength of the bottle. If the bottle has a small circular depression or a broad one, the best way to make the bottle is with a flat bottom.

The screw cap is opaque and engaged with threads on the upper portion of the neck because transparent material is more expensive and difficult to work with on a screw cap. The screw cap should be softer and thus opaque materials are better at forming the screw cap. It would be more expensive to make transparent screw caps because the plastic is more expensive. If a user can see through the wall of the bottle, it is not that big of a deal that the user cannot see through the screw cap. The screw cap engages with threads because it is easier to screw on a bottle cap rather than snap it on. The snap on version is too easily snapped off. The screw configuration is a better way to seal the bottle with certainty.

The screw cap has a button connected to the center of its top surface via a short stem because the screw cap is tethered to the bottle. The tether rotates about the button that serves as an axis of rotation to retain the tether to the cap. Once the user takes off the cap, the tether is very helpful because otherwise the cap would be lost or roll away. The connection is formed as a button because the button configuration provides a good axial connection while maintaining low weight and cost. The button is essentially a rivet that turns. If the tether were directly formed to the screw cap, the screw cap would stop turning because the tether would bias the screw cap by exerting a clockwise force. Therefore, an axial connection is preferred. The tether connection to the shrink ring was the easiest connection. Other alternatives such as Sonic welding would require additional machinery and production process. The tether connection to the shrink ring provides a manual solution for connection.

The strap terminates in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, because the small ring is necessary for rotation with the cap, and the large ring is necessary for connection with the shrink ring. The button stem is preferably encircled because that provides a pivotal connection. The strap is visually distinct from the screw cap because they are separate parts. They are separate parts because the screw cap needs to rotate around the mouth of the bottle while the strap remains stationary. If the strap rotates with the screw cap, the strap will interfere with the hand of the user especially if the user is removing or putting the cap on using a single hand. The top ring is smaller because it does not need to be very large for the connection with the cap. Though bottom ring is larger because it must fit around the shrink ring near the base of the bottle. If the top ring were larger than the bottom, the ring would protrude over the top surface of the cap and hinder the fingers of the user. The top ring should be smaller than the top of the top surface of the cap because the fingers of the user preferably grasp the interface between the top surface of the cap and the side surfaces of the cap. The top ring being in the same size as the top surface of the cap would limit the user to grasping only the side surfaces of the cap. This limitation would prevent a user from tightening the cap as much as a user could have if the user had access to grab more surface area on the cap.



The ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately .4 because in a 500ml cylindrical container, that ratio produces a circumference that is approximately equivalent to the size of an average person's hand. The .4 ratio is particularly comfortable and easy to hold. If the container were overly long, it would require additional plastic to create and would not be as strong. The overlong container would also not be as strong because is more of a stick shaped container. The 500ml cylindrical container is a standard size. It is half a liter. A liter is a metric size. Metric units are widely adopted in the world. A metric units are particularly helpful in science because all of the unit's are based 10. Dealing with inches and feet, and gallons makes calculations difficult. Therefore, the standard size half liter container is particularly well-suited for a person's hand when .4 ratio is in place.

The ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8 because with the .4 ratio previously mentioned, the cap would be on the order of several inches in height. Having a cap that produces a .7 ratio would make the cap size overly long and create a long neck that is taller than it is wide. Having a cap that produces a .9 ratio would make the gripping area too small for an average person's fingers. Therefore, the .8 ratio is derived from the .4 ratio which is derived from the combination of the standard size 500ml container in combination with an average person's hand size.

The container is designed to hold water because it is a bottle. Water is the most plentiful liquid on the planet. A wide variety of liquids can be stored within the container. If the container were not designed to hold water, it would not work as well as a container that could hold water. Humans drink water during exercise and on a daily basis. Humans are comprised of a substantial percentage of water weight. Therefore, the opposer designed the bottle to hold water because holding water is a convenient and utilitarian function of a bottle.

**INTERROGATORY NO. 12:**

Identify all other configurations Opposer considered as alternatives to a water bottle

having Applicant's Bottle Configuration or a similar configuration, and produce all documents related thereto, including, but not limited to, photographs and drawings of such alternative configurations.

**RESPONSE TO INTERROGATORY NO. 12:**

For the above reasons previously stated, the opposer adopted a bottle that happened to be described in the description of the mark. The opposer adopted the bottle design described in the description of the mark because the description of the mark describes a typical narrow mouth bottle that has a tether.

**INTERROGATORY NO. 13:**

Identify all persons who were involved in the selection, design, development, adoption and use of a water bottle configuration having Applicant's Bottle Configuration, or a similar configuration, and for each person, state his/her title, and the role s/he played to select, design, develop, adopt and use such.

**RESPONSE TO INTERROGATORY NO. 13:**

The opposer does not have sufficient knowledge to answer this interrogatory other than to say that Owens Illinois made the first Boston Round configuration. Regarding the design, development, adoption and use of the standard water bottle configuration, these should be available on the United States Patent Office website or in other public domain databases.

**INTERROGATORY NO. 14:**

For each product identified in response to Interrogatories Nos. 1 and 7, explain in detail the reasons for selecting such product configuration.

**RESPONSE TO INTERROGATORY NO. 14:**

Please see answer to the interrogatory 11.

**INTERROGATORY NO. 15:**

For each alternative configuration identified in response to Interrogatory No. 12, explain in detail why such design was not selected.

**RESPONSE TO INTERROGATORY NO. 15:**

Please see answer to the interrogatory 11.

**INTERROGATORY NO. 16:**

Describe in detail all circumstances when Opposer has marketed, advertised, or promoted

a water bottle bearing Applicant's Bottle Configuration or a similar configuration, including the dates and media channels or such marketing, advertising or promotion, and identify all documents related thereto.

**RESPONSE TO INTERROGATORY NO. 16:**

The opposer sold the goods to the vendors that received the cease and desist letters from Apogent. Thereafter, the opposer's business in selling the goods was substantially harmed.

**INTERROGATORY NO. 17:**

When did Opposer first become aware of (1) Applicant, (2) Applicant's Mark and (3) the application of Applicant's Mark, namely, U.S. Application Serial No. 76/572,253.

**RESPONSE TO INTERROGATORY NO. 17:**

Opposer is not exactly sure of the dates, but knows that the notice of all these came from Apogent's cease and desist letters beginning in about September 2004.

**INTERROGATORY NO. 18:**

For each product identified in response to Interrogatory No. 7 state (1) the country(s) in which the product is manufactured and (2) the costs of manufacturing such product.

**RESPONSE TO INTERROGATORY NO. 18:**

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

**INTERROGATORY NO. 19:**

Identify all inquiries, investigations, surveys, evaluations and/or studies, legal or otherwise, conducted by Opposer or by anyone acting for or on its behalf with respect to use of a configuration similar to Applicant's Mark, including the date conducted, the name, address and title of each person who conducted it, the purpose of being conducted, the findings or conclusions made, and identify all documents related thereto.

## **RESPONSE TO INTERROGATORY NO. 19:**

This interrogatory is objected to on the basis of seeking attorney work product that is attorney work product privileged. To the extent that discoverable evidence is not an attorney work product privileged, it is described below. Fisher Scientific owns Apogent that owns Nalgene. Fisher Scientific also owns Cole-Parmer.

1. The following sites have been used for searches on the Boston Round configuration indicating that Applicant's Mark is simply a connected cap on their existing (advertised) bottle listed as Boston Round.

- a. [www.fishersci.com](http://www.fishersci.com) (Applicant's parent company)

- i. <https://www1.fishersci.com/Search;jsessionid=DtIVY6X66GHzkJN6LwuZvEf1Soi5i2JYnY5JAfTIuOTX5xrDO692!917591203?t=r&key=boston+round>

- ii.

Nalgene\* Polypropylene Boston Round Bottles  
Excellent chemical resistance

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Fisher Catalog > Bottles > Plastic Bottles [General Purpose] > Round Plastic Narrow Mouth Bottles > Nalgene\* Polypropylene Boston Round Bottles

With polypropylene screw closures. Ideal for lab applications requiring excellent autoclaving of containers with or without contents.

**Note:** Completely disengage threads or remove closure before autoclaving. Leakproof.<sup>1</sup>



02-925 and 02-923-11  
Series

- b. [www.vwrsp.com](http://www.vwrsp.com)

- i. <http://www.vwrsp.com/psearch/ControllerServlet.do?D=boston+round&CurSel=Ntt&Ntt=boston+round&Ntk=All&Ntx=mode%2bmatchpartialmax&Np=2&N=0&Nu=RollupKey&cntry=us&Nty=1&custpartgrp=null>

- c. [http://www.coleparmer.com/opproducts/nalgene\\_bottles.html](http://www.coleparmer.com/opproducts/nalgene_bottles.html)

## Nalgene Bottles

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Whether your laboratory storage needs include pharmaceutical, chemical, or other commercial applications, Cole-Parmer offers a wide selection of Nalgene® bottles. Choose from narrow-mouth, wide-mouth, wash, solution and other use bottles. Nalgene® bottles are available in various sizes and specifications including polypropylene and polyethylene. Check out our catalog's selections and you'll find the Nalgene® bottles with the features you need, like some of the features of the Model EW-06035-70 (pictured) listed below.

Nalgene Bottles Quick Link

**Model EW-06035-70 — Nalgene® Narrow-Mouth High-Density Polyethylene (HDPE).** All-purpose Boston round Nalgene® bottles are popularly used for packaging, shipping, and storage because of their reliable durability. Rigid, translucent, and chemical-resistant, Nalgene® bottles can be used with most corrosives. All have leakproof polypropylene (PP) screw closures.

d. <https://www1.fishersci.com/Coupon?cid=1328&gid=43890>



e.

*\*The Polycarbonate Boston Round Bottle with identical measurements, shape and profile being sold by the applicant's parent company without a tethered cap. Just as the opposer is selling a Boston Round Bottle is sold in the lab market with a tethered cap filled with reagents and culture media.*

Characteristics	Cat. No.	Qty.	Price
			Add To Shopping Cart ➔

Screw Cap Size: 38mm-430; NNI  
No.: 2205 0016; Capacity: 16 oz.

02-960-52E  
NNI No.:2205-0016



- ☒ Pack of 4 for \$37.64
- ☐ Case of 6 for \$150.56

**Add To Shopping Cart** →

Screw Cap Size: 38mm-430; NNI  
No.: 2205 0032; Capacity: 1/4gal.

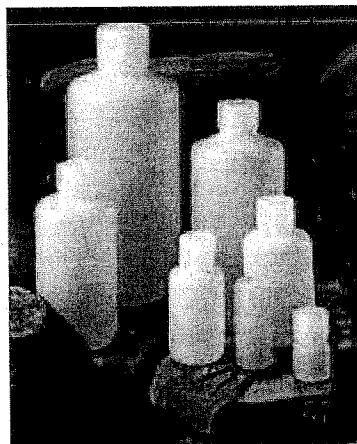
02-960-52F  
NNI No.:2205-0032



- ☒ Pack of 4 for \$52.64
- ☐ Case of 6 for \$210.54

**Add To Shopping Cart** →

- f. [www.nalgenepackaging.com](http://www.nalgenepackaging.com)
  - i. [http://www.nalgenepackaging.com/products/productDetail.asp?product\\_id=632&subcategory\\_id=&category\\_id=123&brand\\_name=NALGENE+Packaging&category\\_name=Lab+Quality+Bottles&subcategory\\_name=](http://www.nalgenepackaging.com/products/productDetail.asp?product_id=632&subcategory_id=&category_id=123&brand_name=NALGENE+Packaging&category_name=Lab+Quality+Bottles&subcategory_name=)
- g. <http://www.nalgene-outdoor.com/store/category.asp?category=Narrow-Mouth+Bottles>
- h. <http://store.karstsports.com/nalnarmoutlo.html>
  - i. Sports Market Distributor selling the same bottle with a tether cap and with screw cap without tether, being called narrow mouth bottle.
- i. <http://www.rei.com/product/484.htm>
  - i. Nalgene Narrow-Mouth Polyethylene Bottle - 16 oz.  
\$4.25 Item 402188  
Same bottle called Boston Round made with HDPE, LDPE.



**INTERROGATORY NO. 20:**

For each good sold by Opposer bearing Applicant's Mark or a similar configuration,

identify the target consumers or ordinary purchasers, including their sophistication, the level of care exercised by such customers or purchaser in purchasing such goods or services.

**RESPONSE TO INTERROGATORY NO. 20:**

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

**INTERROGATORY NO. 21:**

For each good Opposer sells and promotes, or intends to sell and promote, in connection with a water bottle bearing Applicant's Bottle Configuration or a similar configuration, identify with specificity the price range, at the wholesale and/or retail level, at which Opposer sells or intends to see such goods, and identify all documents related thereto.

**RESPONSE TO INTERROGATORY NO. 21:**

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

**INTERROGATORY NO. 22:**

For each good identified in response to Interrogatories Nos. 1 and 7, set forth the dollar amount of the gross quarterly sales of such goods, if any, and the dollar amount of quarterly advertising expenditures.

**RESPONSE TO INTERROGATORY NO. 22:**

Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition. Without waiving the objection that this interrogatory is vague the, opposer answers that the amount is insubstantial compared to the amount of sales of the applicant. The amount is insubstantial because of the unfair claiming of Patent features as trade dress features, and the related threats of litigation.

**INTERROGATORY NO. 23:**

Identify the date when a water bottle bearing Applicant's Bottle Configuration or a similar configuration was last sold by or on behalf of Opposer and provide all supporting documents thereto.

**RESPONSE TO INTERROGATORY NO. 23:**

The opposer objects to this interrogatory as being vague. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. This is of course Apogent's strategy because the difficulty in defining limitations on the claims is an excellent way to deter competition.

**INTERROGATORY NO. 24:**

Identify each statement or opinion, oral or written, obtained by or for Opposer regarding any issue in this Opposition proceeding, and identify all documents which record, refer to, or relate to such statement or opinion.

**RESPONSE TO INTERROGATORY NO. 24:**

This interrogatory is objected to as being over broad and vague.



**INTERROGATORY NO. 25:**

Identify all water bottle configurations used by third parties, registered or common law, for goods related to those goods listed in response to Interrogatory No. 1. Explain when Opposer first became aware of these configurations, what action Opposer has taken with respect to each of these trademarks, and the outcome of such action.

**RESPONSE TO INTERROGATORY NO. 25:**

The opposer has not compiled a comprehensive list of water bottle configurations used by third parties. The opposer reserves the right to supplement this interrogatory. So far, there are only the configurations in the production of documents and in the opposition.

**INTERROGATORY NO. 26:**

State in detail the channels of trade through which Opposer uses and markets, or intends to use and market a water bottle bearing Applicant's Bottle Configuration or a similar configuration, including the geographic area by state, the manner in which the goods reach the ultimate consumer, the specific names of retail store establishments, the approximate percentage of goods sold through each channel, and total sales, if any, of goods through each channel.

**RESPONSE TO INTERROGATORY NO. 26:**

Opposer plans to market in general retail and wholesale in the sports, general goods and laboratory markets.

**INTERROGATORY NO. 27:**

Identify with specificity the media and marketing methods used by or on behalf of Opposer in the promotion and sale of goods bearing Applicant's Bottle Configuration or a similar configuration without limitation, the names of newspapers, magazines, or periodicals.

**RESPONSE TO INTERROGATORY NO. 27:**

The opposer objects to this interrogatory as being vague. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define.

**INTERROGATORY NO. 28:**

Identify all persons or entities, other than Applicant, and set forth with specificity all facts with whom Opposer has had contact regarding, relating or referring to Applicant's Mark, and identify all supporting documents related thereto.

**RESPONSE TO INTERROGATORY NO. 28:**

The opposer objects to this interrogatory as being vague and overbroad. Because the products are difficult to define, this interrogatory cannot be answered. The idea behind a patent claim is that there is certainty in the limitations and patent claims are subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define.

**INTERROGATORY NO. 29:**

Identify all plastic water bottles produced, manufactured or distributed by Owens-Illinois and Brockaway Glass.

**RESPONSE TO INTERROGATORY NO. 29:**

The opposer does not know all of the production of these companies. It is believed that these companies produce a wide variety of products.

**INTERROGATORY NO. 30:**

Describe, define or otherwise explain in detail the meaning of "standard sizes in the marketplace," "standard laboratory machines," and "related bottle holders" as used in the Notice of Opposition.

**RESPONSE TO INTERROGATORY NO. 30:**

The standard sizes in the marketplace refer to industry standards. Industry standards are common sizes or shapes that are adopted by a wide variety of companies in a particular field. For example, water bottles are typically sold in 500ml containers. Standard laboratory machines refers to machines that are configured and designed to accept a particular size or shape of container. For example, some laboratory machines roll the bottle for mixing. Square bottles do not roll very well. Therefore the standard in this case would be that the bottle is cylindrical. Related bottle holders refers to standard sized holders for the bottles. Because bottles are

standard sized, the bottle holders would be adapted to receive the standard sized bottles. The standard size is a result of various companies in the bottle industry making bottles that are of similar shape and size and dimensions. Because the various companies in the bottle making industry make bottles that are similar, laboratory machines will also make machines that receive those bottles.

**INTERROGATORY NO. 31:**

Describe in detail the cost of manufacturing the goods identified in response to Interrogatories No. 1 and No. 7.

**RESPONSE TO INTERROGATORY NO. 31:**

The opposer objects to this interrogatory as seeking confidential trade secrets, as irrelevant and as not calculated to lead to discoverable evidence.

**INTERROGATORY NO. 32:**

Explain in detail why Opposer filed a patent application for a water bottle having features similar to Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 32:**

Like the applicant, Opposer wanted to be able to sue people for making standard products. Unfortunately, opposer was thwarted by the patent office because of novelty issues.

**INTERROGATORY NO. 33:**

Identify each witness that Petitioner expects to testify, the subject matter to which the witness is expected to testify, each fact and/or opinion to which the witness is expected to give, the bases for each statement or opinion and identify all documents related thereto.

**RESPONSE TO INTERROGATORY NO. 33:**

The opposer has not figured out the witnesses yet. Witnesses may not be necessary if the opposer wins without trial. The opposer reserves the right to supplement this interrogatory.

**INTERROGATORY NO. 34:**

Identify each person who participated in or supplied information used in answering any of the above interrogatories; beside the name of each such person, state the number of the interrogatory answer(s) that person answered or supplied information.

**RESPONSE TO INTERROGATORY NO. 34:**

Steve Lin

**INTERROGATORY NO. 35:**

Identify all facts and documents supporting contention that in the Notice of Opposition that "[t]he 76572253 mark is functional and does not have secondary meaning."

**RESPONSE TO INTERROGATORY NO. 35:**

The answer to this interrogatory is in interrogatory response 11.

**INTERROGATORY NO. 36:**

Identify all facts and documents that Opposer claims show that the exclusive use by Applicant of Applicant's Mark would put competitors at a significant non-reputation-related disadvantage.

**RESPONSE TO INTERROGATORY NO. 36:**

The opposer objects to this interrogatory as being vague and overbroad. Applicant will have a perpetual patent claim that grows with time and has no certainty in the limitations and is not subject to the all limitations rule. A patent owner cannot remove limitations and elements from the patent claim, but Apogent (parent company of Nalgene) has sent cease and desist letters removing many elements and limitations from the 'patent claim' that was granted by the trademark Office. Therefore, the scope of the trademarks is now impossible to define. The functional advantages of the product are previously described in interrogatory response 11.

**INTERROGATORY NO. 37:**

Identify all facts and documents Opposer claims show that there are no alternative designs available that are functionally equivalent to the design of Applicant's Mark.

**RESPONSE TO INTERROGATORY NO. 37:**

The patent like claim given to applicant will, from time to time, shed limitations and elements from the claim, until applicant has a monopoly on all water bottles. Apogent's cease and desist letters remove many elements and limitations from the patent like claim that was granted by the Trademark Office.

This pattern of unfair competition and misuse of trademark registration provides an unfair advantage to large corporations. As a small start up company involved in selling plastic consumables we are concerned with the unfair and the monopolistic trade practices of the giant corporations.

**INTERROGATORY NO. 38:**

Identify all facts and documents Opposer claims show the design of Applicant's Mark provides for a simpler or cheaper method of manufacture than alternative designs.

**RESPONSE TO INTERROGATORY NO. 38:**

The functional advantages of the product are previously described in interrogatory response 11.

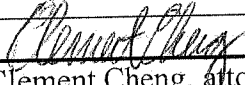
**INTERROGATORY NO. 39:**

Identify all facts and documents supporting Opposer's contention in the Notice of Opposition that:

- A. "If the 76572253 mark is allowed to be registered, the applicant Nalgene would have a monopoly on the traditional Boston Round."
- B. "The applicant [sic, Opposer] also sells this type of bottle and would be injured if the application were registered."
- C. "The button is necessary to connect the tether in swivel configuration to the cap."
- D. "Opposer has filed a utility patent application for the connector 'tether' and opposer's bottle is also sold to the same customers."
- E. "The round profile contributes substantially to the strength of the bottle."
- F. "The upper annular ring is configured to allow a shrinkwrap machine shrinkwrap the top of the cap to the bottle."
- G. "The overall height of the water bottle and . . . are established by standard sizes in the marketplace. The ratios are commercially necessary so that the bottles will fit into standard laboratory machines, packaging machines, and related bottle holders."

**RESPONSE TO INTERROGATORY NO. 39:**

The functional advantages of the product are previously described in interrogatory response 11. This interrogatory has been answered by the above responses to interrogatory 1-38. The opposer incorporates by reference the responses to interrogatory 1-38.

<u>2/28/06</u> Date (714) 825-0555; (714) 825-0558 fax	 Clement Cheng, attorney for applicant Newhope Law, PC 17220 Newhope St Ste 127 Fountain Valley, CA 92708-4283
--	--

**VERIFICATION**

I am an officer of TriForest Enterprises, Inc., the opposer in this action and am authorized to make this verification on its behalf. I have read and reviewed the above **OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S FIRST SET OF INTERROGATORIES** and know the contents. The same is true of my own knowledge, except as to those matters that are alleged on information and belief, as to those matters, I believe it to be true.

I declare under penalty of perjury according to this the laws of the State of California that the above is true and correct.

Executed on May 29, 2006 (date) in the city of Irvine, California

X: 

signature

**PROOF OF SERVICE**

**In the matter of App Ser. No. 76/572,253**

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 28, 2006, I served:

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S  
FIRST SET OF INTERROGATORIES**

By placing true copies thereof in a seal envelope, addressed as follows to:

Donald L. Frei

Sarah Otte Graber

WOOD, HERRON & EVANS, LLP

2700 Carew Tower

441 Vine Street

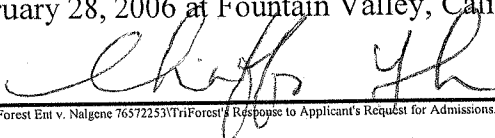
Cincinnati, OH 45202-2917

(513) 241-2324

Attorney's for Applicant Nalge Nunc International Corporation

- ☒ **BY MAIL:** I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ **FEDERAL:** I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on February 28, 2006 at Fountain Valley, California.



United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: July 11, 2005

Opposition No 91165809  
Serial No. 76572253

DONALD F. FREI  
WOOD, HERRON & EVANS, L.L.P.  
2700 CAREW TOWER 441 VINE STREET  
CINCINNATI, OH 45202-2917

TriForest Enterprises, Inc.

v.

Nalge Nunc International  
Corporation

Clement Cheng  
Law Offices of Clement Cheng  
17220 Newhope St Ste 127  
Fountain Valley, CA 92708-4283

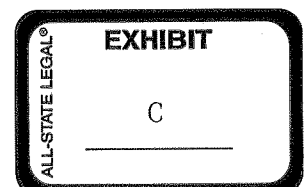
Pauline Stewart, Legal Assistant

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at [www.uspto.gov/web/offices/dcom/ttab/](http://www.uspto.gov/web/offices/dcom/ttab/).

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including





but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	July 31, 2005
Discovery period to close:	January 27, 2006
30-day testimony period for party in position of plaintiff to close:	April 27, 2006
30-day testimony period for party in position of defendant to close:	June 26, 2006
15-day rebuttal testimony period for plaintiff to close:	August 10, 2006

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

#### **New Developments at the Trademark Trial and Appeal Board**

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.



**PROOF OF SERVICE**

**In the matter of App Ser. No. 76/572,253**

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On June 23, 2006 I served:


**OPPOSER, TRIFOREST ENTERPRISES, INC.'S NOTICE OF  
TAKING TESTIMONY BY DEPOSITIONS**

By placing true copies thereof in a seal envelope, addressed as follows to:

Brett A. Schatz  
WOOD, HERRON & EVANS, LLP  
2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202-2917  
(513) 241-6234 fax  
Attorney's for Applicant Nalge Nunc International Corporation

- ☐ BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s).
- ☒ BY MAIL: I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ FEDERAL: I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on June 23, 2006 at Fountain Valley, California.

  
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